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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/808,107

03/24/2004

Peter Davis

342202-1010

4167

24504

7590

09/22/2008

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EXAMINER

LAstra, DANIEL

ART UNIT

PAPER NUMBER

3688

MAIL DATE

DELIVERY MODE

09/22/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/808,107	<b>Applicant(s)</b> DAVIS, PETER	
	<b>Examiner</b> DANIEL LASTRA	<b>Art Unit</b> 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-33 have been examined. Application 10/808,107 (SYSTEMS AND METHODS FOR PROMOTING SAVINGS THROUGH A COMPUTER-ENABLED CERTIFICATE PROGRAM) has a filing date 03/24/2004 Claims Priority from Provisional Application 60457501, filed 03/24/2003.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-4, 13, 14 and 23-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. With respect to claims 2-4, 13, 14 and 24-33. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus). With respect to claim 1, said claim is defined as system claim however, it is claiming "an

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agreement to a consumer” which it is not a system but functional descriptive material (i.e. software). Claim 23 is defined as system claim however, “a receiving unit” and issuing unit are defined as functional descriptive material (i.e. software).

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 13, 14 and 23-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2-4, 13, 14 and 24-33 are indefinite because do not contain structure. Claims 1 and 23 are indefinite because they are not system claims.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2-6, 9-11, 15-18, 21-24, 27-29 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Carroll (US 2002/0023026).

Claim 2, Carroll teaches:

A method for implementing an on-line certificate program, comprising the steps of:

marketing a certificate program (see paragraphs 43-44);

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receiving a purchase request for a certificate (see paragraphs 43-44);  
processing the purchase request for the certificate (see paragraphs 43-44);  
issuing the certificate (see paragraphs 43-44); and  
redeeming the certificate (see paragraphs 43-44).

Claim 3, Carroll teaches:

wherein the step of redeeming the certificate comprises adding value to an account (see paragraphs 43-44); wherein the account is designated by a certificate recipient (see paragraph 43).

Claim 4, Carroll teaches:

wherein the certificate further comprises an electronic certificate, wherein the step of issuing the electronic certificate is performed electronically (see paragraph 43).

Claim 5, Carroll teaches:

wherein the electronic certificate further comprises a link to a networked computer; wherein the networked computer is configured to perform the step of redeeming the electronic certificate (see paragraph 43).

Claim 6, Carroll teaches:

Creating a transaction record, wherein the transaction record further comprises a unique serial number (see paragraph 43 “unique link”).

Claim 9, Carroll teaches:

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establishing a communication link with an issuer;  
communicating data relating to the certificate; and  
crediting the account with the value of the certificate (See paragraphs 43-44).

Claim 10, Carroll teaches:

wherein the communication link is selected from  
the group consisting of telephonic, computer network and physical delivery (see  
paragraph 43).

Claim 11, Carroll teaches:

creating a transaction record, wherein the transaction record further comprises a  
unique serial number (see paragraph 44).

Claim 15, Carroll teaches:

A computer readable medium having a computer program for  
implementing a certificate program, the computer program for performing the steps of:  
receiving an order to purchase a certificate, wherein the certificate comprises a  
monetary value (see paragraphs 43-44);

processing the order to purchase the certificate (see paragraphs 43-44);

issuing the certificate (see paragraphs 43-44);

redeeming the certificate (see paragraphs 43-44); and

depositing the monetary value into an account (see paragraphs 43-44).

Claim 16, Carroll teaches:

wherein the step of receiving an order to purchase a certificate further comprises  
the steps of:

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receiving identification data relating to a purchaser (See paragraph 44);  
receiving identification data relating to a recipient (see paragraph 43);  
receiving data relating to the monetary value (see paragraphs 43-44);  
receiving financial data relating to payment for the certificate (see paragraph 43); and  
generating a certificate transaction (see paragraph 43).

Claim 17, Carroll teaches:

wherein the step of processing the order to purchase the certificate further  
comprises the step of creating a transaction record, wherein the transaction record  
further comprises a unique serial number (see paragraph 44).

Claim 18, Carroll teaches:

wherein the step of issuing the certificate comprises the step of transmitting the  
certificate directly to the recipient, wherein the certificate is transmitted electronically to  
a computer (see paragraph 43).

Claim 21, Carroll teaches:

wherein the step of depositing the monetary value into an account further  
comprises the step of transmitting the monetary value to an existing account, wherein  
the account is designated by the recipient (see paragraph 27).

Claim 22, Carroll teaches:

wherein the step of depositing the monetary value into an account further  
comprises the steps of:

creating the account, wherein the account is designated by the recipient; and  
transmitting the monetary value to the account (see paragraph 27).

Claim 23, Carroll teaches:

An electronic device for processing and managing a certificate program for increasing the value of a recipient designated account, the device comprising: a receiving unit for receiving a purchase request for a certificate (see paragraph 44); a processing unit for processing the purchase request; an issuing unit for issuing the certificate, wherein the certificate comprises a monetary value (see paragraph 44);

an account creating unit for creating an account; and a redemption unit for redeeming the certificate (see paragraph 44); wherein the redemption unit is configured to deposit the monetary value into the recipient designated account (see paragraph 43).

Claim 24, Carroll teaches:

A method for processing an on-line certificate program, the method comprising the steps of:

purchasing a certificate (see paragraph 44);

issuing the certificate, wherein the certificate is transmitted to a recipient (see paragraph 43);

redeeming the certificate for a monetary value (see paragraph 43); and

directing the monetary value to a savings vehicle, wherein the savings vehicle is selected by the recipient (see paragraph 43).

Claim 27, Carroll teaches:



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wherein the step of purchasing the certificate further comprises receiving a payment (see paragraph 44).

Claim 28, Carroll teaches:

wherein the payment is selected from the group consisting of cash, credit account, credit card, and check (see paragraph 44).

Claim 29, Carroll teaches:

herein the savings vehicle is selected from the group consisting of a savings account, a college savings account, a retirement savings account, a mutual fund, a certificate of deposit, a money market account and a brokerage account (see paragraph 27).

Claim 31, Carroll teaches:

wherein the step of purchasing the certificate is performed by an individual (see paragraph 44).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carroll (US 2002/0023026) in view of Postrel (6,594,640).

Claim 1, Carroll teaches:

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A system for promoting savings by enabling a consumer through at least one covered electronic transaction to convert loyalty points or other currency for a direct deposit into a savings vehicle, said system comprising: an agreement with a consumer, wherein certain points are converted into a value, wherein the value is deposited (see paragraph 40);

a plurality of electronic data processing devices, wherein each of the plurality of electronic data processing devices is configured to communicate electronic data with at least one other of the plurality of electronic data processing devices, wherein the electronic data comprises information relating to a certificate (see paragraphs 43-44); a first electronic data processing device of the plurality of electronic data processing devices, further configured to transmit purchase data to a second electronic data processing device of the plurality of electronic data processing devices, wherein the purchase data comprises payment method data (see paragraph 44), wherein the purchase data further comprises consumer data, wherein the purchase data further comprises purchaser data, wherein the purchase data further comprises a certificate value (see paragraph 44);

the second electronic data processing device, further configured to receive the purchase data, wherein the second electronic data processing device is further configured to enter an order, wherein the order is stored in an electronic database, wherein the second electronic data processing device is further configured to generate a unique transaction identifier (see paragraph 44), wherein the second electronic data processing device is further configured to create a certificate data record, wherein the

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certificate data record is stored in an electronic customer database, wherein the certificate data record is transmitted to a third electronic data processing device of the plurality of electronic data processing devices (see paragraph 44);

the third electronic data processing device, further configured to receive the certificate data record; wherein the third electronic data processing device is further configured to transmit the certificate data record to a fourth electronic data processing device of the plurality of electronic data processing devices for the purpose of redeeming the certificate data record (see paragraph 43); wherein the third electronic data processing device is further configured to transmit account data (see paragraph 43); where the account data identifies how the certificate value is directed (see paragraph 27);

the fourth electronic data processing device, further configured to receive the certificate data record and the account data (see paragraph 43); wherein the fourth electronic data processing device is further configured to create the account for a new consumer; wherein the fourth electronic data processing device is further configured to deposit the certificate value into a financial institution (see paragraphs 27 and 43).

Carroll does not expressly teach wherein the certain points are converted at a conversion rate, wherein the conversion rate is determined by the agreement. However, Postrel teaches that it is old and well known in the promotion art to use a conversion rate to convert loyalty points to a monetary value (see col 8, lines 5-25). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the loyalty points accumulated by a member and

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deposited into a investment account in the Carroll's system (see paragraph 40) would be converted to a money amount at a conversion rate, as it is old and well known to do so, as taught by Postrel.

Claim 25, Carroll teaches:

wherein the step of purchasing the certificate further comprises converting award program loyalty points, wherein the award program loyalty points are assigned a currency value (see paragraph 40) but does not teach wherein the currency value corresponds to the monetary value of the certificate. However, Postrel teaches that it is old and well known in the promotion art to use a conversion rate to convert loyalty points to a monetary value and use said monetary value to purchase products or services (see col 8, lines 5-25). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the loyalty points accumulated by a member and deposited into a investment account in the Carroll's system (see paragraph 40) would be converted to a money amount at a conversion rate and would be used to purchase certificates, as it is old and well known to use loyalty points to purchase products or services, as taught by Postrel.

Claim 26, Carroll teaches:

wherein the savings vehicle is selected from the group consisting of a savings account, a college savings account, a retirement savings account, a mutual fund, a certificate of deposit, a money market account and a brokerage account (see paragraph 27).

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6. Claims 7, 8, 12-14, 19, 20, 30, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carroll (US 2002/0023026).

Claims 7 and 12, Carroll does not expressly teach:

wherein the unique serial number comprises information content relating to the identity of the person redeeming the certificate, wherein the unique serial number further comprises information content relating to the date of issuance of the certificate; wherein the unique serial number further comprises information content relating to the date the redemption of the certificate; wherein the unique serial number further comprises information content relating to the identity of the purchaser of the certificate. However, Official Notice is taken that it is old and well known in the promotion art to identify reward vouchers or certificates with customer information in order to allow said customers to redeem said vouchers or certificates in a pos terminal. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Carroll's certificates would include identification data that would allow carriers of said certificate to redeem said certificates.

Claim 8, Carroll does not teach:

wherein the certificate comprises a paper certificate, wherein the step of issuing the paper certificate comprises the step of creating an electronic certificate transaction record; wherein the step of issuing the paper certificate further comprises transmitting the electronic transaction record to a printing facility. However, Official Notice is taken that it is old and well known in the

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promotion art to print a digital file in hard copy form. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Carroll's electronic certificates would be printed in hard copy form as it is old and well known to print electronic files in hard copy form.

Claim 13, Carroll does not teach:

wherein the step of marketing the certificate program further comprises the step of directly soliciting business entities to participate in the certificate program. However, Official Notice is taken that it is old and well known in the promotion art for business entities such as employers to issue gift certificates in order to compensate employees. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Carroll's system would solicit business entities to become gift donors, as it old and well known to do so.

Claim 14, Carroll does not teach:

wherein the step of marketing the certificate program further comprises the step of establishing a network of marketing agencies; wherein the marketing agencies resell the certificates. However, Official Notice is taken that it is old and well known in the promotion art for agencies to resell certificates. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Carroll's certificates would be resold by agencies as it is old and well known to do so.

Claim 19, Carroll does not teach:

wherein the step of issuing the certificate comprises the step of transmitting the certificate transaction to a certificate printing facility; wherein the certificate printing facility transmits a printed certificate directly to the recipient. However, Official Notice is taken that it is old and well known in the promotion art to print a digital file in hard copy form. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Carroll's electronic certificates would be printed in hard copy form and mail to recipients as it is old and well known to print electronic files in hard copy form.

Claim 20, Carroll teaches:

wherein the step of redeeming the certificate comprises a step selected from the group of: establishing a computer link, wherein the computer link is established via an internet website (see paragraph 43);

but does not teach communicating via telephone; and transmitting a printed certificate to the issuer. However, Official Notice is taken that it is old and well known in the promotion art to print a digital file in hard copy form and communicates information via telephone. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Carroll's electronic certificates would be printed in hard copy form as it is old and well known to print electronic files in hard copy form.

Claim 30, Carroll does not teach:

wherein the step of redeeming the certificate further comprises designating an organization, wherein the organization comprises a

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non- profit organization. However, Official notice is taken that it is old and well known in the promotion art to donate gifts certificates to charities. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Carroll's members would donate gift certificates to charities accounts as it is old known to do so.

Claim 32, Carroll does not teach:

wherein the step of purchasing the certificate is performed by a business organization. However, Official notice is taken that it is old and well known in the promotion art that employers purchase gift certificates for their employees. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Carroll's certificate donors would purchase gift certificate for their employees as it is old and well known to do so.

Claim 33, Carroll does not teach:

wherein the business organization purchases the certificates to provide an employee benefit. However, Official notice is taken that it is old and well known in the promotion art that employers purchase gift certificates for their employees. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Carroll's certificate donors would purchase gift certificates for their employees as it is old and well known to do so.



***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on (571)272-6722. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/  
Examiner, Art Unit 3688  
September 17, 2008